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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,195	12/05/2000	Hitoshi Ishikawa	Q62115	6703

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SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037-3202

EXAMINER

YAMNITZKY, MARIE ROSE

ART UNIT PAPER NUMBER

1774

DATE MAILED: 04/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/729,195

Applicant(s)

ISHIKAWA ET AL.

Examiner

Marie R. Yamnitzky

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003 and 09 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3, 10-13, 23-25 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3, 10-13, 23-25 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>rec'd 17 Nov 2003</u> . | 6) <input type="checkbox"/> Other: _____  |

1. This Office action is in response to applicant's amendment received January 09, 2004, which cancels claims 1, 2, 4-9, 14-22 and 26-29, amends claims 3, 10, 11 and 13, and adds claim 30.

Claims 3, 10-13, 23-25 and 30 are pending.

2. The amendment received January 09, 2004 is a resubmission of an amendment previously filed October 20, 2003, and includes a copy of a postcard receipt showing an original receipt date of October 20, 2003 for the amendment and a petition for extension of time. To date, the original amendment and petition for extension of time have not been matched with the file.

3. All rejections set forth in the Office action mailed April 18, 2003 with respect to claims 1, 2, 4-9, 14-22 and 26-29 are rendered moot by the cancellation of these claims.

The rejection of claims 3 and 10-13 under 35 U.S.C. 102(b) as anticipated by JP 9-268284 is overcome by applicant's amendment.

The rejection of claims 10, 11 and 23-25 under 35 U.S.C. 103(a) as unpatentable over JP 9-268284 is overcome by applicant's amendment. While the prior art encompasses the presently claimed subject matter within its broad disclosure, the prior art provides insufficient motivation to select the particular combination of substituents required to meet the limitations of a compound of general formula [2.1] as defined in present independent claims 3, 10, 11 and 13.

4. Claims 3, 10-13, 23-25 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The fifth line after formula [2.1] in claim 3 and the sixth line after formula [2.1] in each of claims 10, 11 and 13 recite "stylyl group". The term "stylyl" is not a recognized chemical term. The examiner expects that the term "stylyl" is a mistranslation of the term --styryl--. Appropriate correction is required.

The fifth line after formula [2.1] in claim 10 includes a semicolon after "atoms", thus making it unclear as to what the phrase "except for having stylyl group" is modifying. Presuming the "except for having stylyl group" pertains to Ar<sub>3</sub> and Ar<sub>5</sub>, the semicolon after "atoms" in the fifth line after formula [2.1] should be deleted.

5. Claims 3, 10-13, 23-25 and 30 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

6. On March 25, 2004, the undersigned examiner spoke to Lee Wright and proposed doing an examiner's amendment to change "stylyl" to --styryl-- and to delete the semicolon as noted in the rejection under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, so to put the claims in condition for allowance.

The examiner made a follow-up phone call on March 31, 2004, at which time the examiner was informed that due to a change in power of attorney not yet of record with the

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Office, Mr. Wright was not able to authorize an examiner's amendment. Mr. Wright notified the examiner that he had passed the examiner's proposed amendment on to the new attorney.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (571) 272-1531. The examiner works a flexible schedule but can generally be reached at this number from 6:30 a.m. to 4:00 p.m. Monday, Tuesday, Thursday and Friday, and every other Wednesday from 6:30 a.m. to 3:00 p.m.

The current fax number for Art Unit 1774 is (703) 872-9306 for all official faxes. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (571) 273-1531.)

MRY  
March 31, 2004



MARIE YAMNITZKY  
PRIMARY EXAMINER

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